

REMARKS

Claims 1–7, 9, 10, and 13–21 are pending in the application. These status of the application is as follows:

Claims / Section	35 U.S.C. Sec.	References / Notes
21	§112, Second Paragraph, Indefiniteness	<ul style="list-style-type: none">• Dependant method of a device claim.
1-7, 9, 10 & 15–21	§102(e) Anticipation	<ul style="list-style-type: none">• Snowbarger, et al. (U.S. Patent No. 7,079,021).
13	§103(a) Obviousness	<ul style="list-style-type: none">• Snowbarger, et al. (U.S. Patent No. 7,079,021); and• Rosenberg (U.S. Patent No. 6,300,937).
14	§103(a) Obviousness	<ul style="list-style-type: none">• Snowbarger, et al. (U.S. Patent No. 7,079,021); and• Scheideler (U.S. Pub. No. 2003/0188583).

5 Applicants thank the Examiner and her supervisor for the courtesy extended during the telephone interview conducted on April 26, 2007.

Applicants have cancelled claims 20 and 21, and have added claims 22–25 for consideration by the Examiner. Applicants have amended independent claims 1 and 9, and provided discussion below for distinguishing the present claims, as
10 amended, from the claims as amended. The amendments and new claims are based on the discussion during the telephone interview.

35 U.S.C. §112, SECOND PARAGRAPH, CLAIM 21 INDEFINITENESS

1. Applicants have cancelled claim 21.

In the OA, on p. 2, the Examiner rejected claim 21 as being indefinite as a method claim depending from an apparatus claim. Applicants have cancelled claim 21 from the application and request that the 35 U.S.C. §112 rejection be withdrawn from the application.

5 **35 U.S.C. §102(e) ANTICIPATION OF CLAIMS 1-7, 9, 10 & 15-19 BY SNOWBARGER**

2. *Applicants have amended independent claims 1 and 9. Snowbarger fails to teach or suggest the elements of transferring the control signal from the position controller to the solenoid valve via the electrical input of the solenoid valve and directly controlling the pneumatic actuator via its pneumatic input with the solenoid*
10 *valve, depending on the control signal provided at the electrical input of the solenoid valve.*

In the OA, on p. 3 (claim 1) and p. 5 (claim 9), the Examiner rejected claim 1 as being anticipated by Snowbarger. The Examiner cited various sections of Snowbarger as reading on each of the elements of claims 1 and 9.

15 Applicants have amended claims 1 and 9 to include limitations that require transferring the control signal from the position controller to the solenoid valve via the electrical input of the solenoid valve and directly controlling the pneumatic actuator via its pneumatic input with the solenoid valve, depending on the control signal provided at the electrical input of the solenoid valve.

20 Snowbarger utilizes the pneumatic lines with its control unit and bypasses the operation of the solenoid valve (note Snowbarger at 5:47ff). This is not an insubstantial difference, because with the configuration of Snowbarger, not all of the

elements are involved in the testing that are involved in the actual operation of the ESD valve—if there were a problem with the solenoid control 20, the test mechanism of Snowbarger would not be able to detect this. In the present application, based on the present amendments to claims 1 and 9, the elements involved in operation are
5 also involved in the testing, which is fundamentally advantageous for a test method.

Based on the amendments, Applicants respectfully contend that independent claims 1 and 9, and all claims that depend therefrom, are not anticipated by Snowbarger and respectfully request that the 35 U.S.C. §102 rejection be withdrawn from the application.

10 **35 U.S.C. §103(a), CLAIMS 13 AND 14 OBVIOUSNESS OVER COMBINATIONS OF
 SNOWBARGER, ROSENBERG, AND SCHEIDELER**

3. *Applicants rely on the arguments above and the amendments with respect to the independent claims in the application, and note that the addition of Rosenberg and Scheideler (cited for other reasons by the Examiner), do not further serve to
15 obviate the independent claims.*

Without addressing the Rosenberg and Scheideler on their merits, Applicants respectfully assert that the addition of Rosenberg and Scheideler to the combination of references does not render the combination as obviating, since the combination fails to teach or suggest all of the elements of the independent claims, as amended
20 in the present application for reasons argued above, and given that neither Rosenberg nor Scheideler teach the elements of the independent claims that are missing from Snowbarger.

For these reasons, Applicants assert that the claim language of the independent claims clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103(a) rejection from the present application.

CONCLUSION

5 Inasmuch as each of the rejections have been overcome by the amendments and arguments presented, and all of the examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered, the rejections be withdrawn and that this application be passed to issue.

10 Any shortages of fees due may be charged to, and any overpayments may be credited to, deposit account no. 50-1519.

Respectfully submitted,

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